

Applicant : Michael G. Platner et al.  
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### REMARKS

In view of the foregoing amendments and the following remarks, reconsideration and allowance are respectfully requested.

Claims 1-31 were pending at the time of this Office Action, with Claims 1, 17, and 27 being independent. No new matter has been added.

Claims 1-4, 6-15, 17-21, 23-30 stand rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 6,370,514 to Messner. Claims 5, 16, 21-22 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Messer in view of U.S. Patent Application No. US 2002/0178071 A1 to Walker.

Claims 1, 3, and 29 are currently being cancelled. Claims 2, 4-28, 30-31 remain pending.

Applicant graciously thanks the Examiner for the interview granted to Applicant's representative. The pending rejections in this matter were discussed, but no formal agreement was reached.

#### 35 U.S.C. 102 Rejections

Independent Claims 17 and 27 are patentable at least because Messner fails to anticipate each and every feature of the claim as arranged in the claim. For a claim to be anticipated by the prior art, it is necessary that a single prior art reference disclose each element of the claim under consideration. *Minnesota Mining and Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992).

Messer fails to disclose the features of "providing at least one of said plurality of certificates from said purchaser to a user" (emphasis added). The Office Action admits that "the combination does not specifically disclose a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user." As supported in the instant disclosure, "The user 430 purchases the certificate 415 from purchaser 420" (Instant Disclosure, p. 22, lines 8-9). Instead, Messer teaches that a centralized voucher server is used for processing transactions (Messer: Abstract). Messer discloses that "a purchaser may buy a gift certificate through a number of routes such as a brick and mortar store, via the telephone, or via an online

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connection.” (Messer: Abstract; Col. 7, lines 51-65). Messer teaches that a purchaser uses a centralized voucher server to purchase gift certificates from merchants. However, the amended Claim 17 also recites “wherein at a time of the providing at least one of said plurality of certificates from said purchaser to said user, information associated with said user is not provided to an entity that provided said plurality of certificates to said purchaser” (from instant disclosure: Fig. 4). Because at least Messer fails to disclose each and every feature of the claims, the 35 U.S.C. 102 rejections to Claims 17, 27 and their dependencies (Claims 18-21, 23-26, 28, 30) should be respectfully withdrawn and those claims be put in condition for allowance. Dependent Claims 2, 4, 6-16 are patentable because they all depend upon an allowable base claim, Claim 5.

#### 35 U.S.C. 103 Rejections.

The amended independent Claim 5 is patentable at least because Messner and Walker fail to teach or suggest each and every feature of the claim. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art (MPEP 2143).

The Office Action admits that “the combination does not specifically disclose a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user.” Furthermore, the Office Action acknowledges that “nor does the combination specifically disclose a method further comprising: providing a commission to said entity; purchasing a second online product by said user; and providing a second commission to said entity as well as wherein said second online product is the same as the first online product” (Office Action: page 7, 5<sup>th</sup> paragraph). Moreover, the Office Action acknowledges that “Walker does not specifically disclose reselling certificates such as coupons” (Office Action: page 8, 1<sup>st</sup> paragraph). If all of these features of the rejected claims are admittedly not taught or suggested in the suggested combination of Messner and Walker, then it is impermissible to apply hindsight to reach an

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obviousness-type rejection rather than reaching a legal conclusion on the basis of the facts gleaned from the prior art (MPEP 2142). Moreover, even if the references could be combined as suggested, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Additionally, Messner cannot be a proper reference under 35 U.S.C. 103 because Messner teaches away from the claim. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (MPEP 2141). For example, Messner not only fails to teach or suggest the claimed features of "wherein said certificate is sold to a purchaser and said purchaser sells said certificate to said user" as discussed above, but Messner teaches away from the claims in that it "is strongly preferred, however, regardless of the means of purchasing the certificate, that the purchase be processed through the voucher server 54" (Messner: Col. 7, lines 55-58, emphasis added). The teaching of the centralized voucher server for processing transactions (Messner: Abstract) teaches away from the claim in that a voucher server is required for an automatic payment system for on-line transactions (Messner: Col. 8, lines 65-67), delivery of the gift certificate (Messner: Col. 9, lines 51-53), redemption of coupons (Messner: Abstract), and relay of the payments received by a store for gift certificates to an operator of the voucher server (Messner: Col. 11, lines 5-8).

Moreover, the amended Claim 5 is patentable at least because Claim 5 recites "wherein at a time of the sale of said certificate to said user, information associated with said user is not provided to an entity that provided said certificate to said user" (from instant disclosure: Fig. 4). In contrast, Messner teaches strongly preferring information associated with the user, such as the user's personal information (Messner: Col. 4, lines 15-21; Col. 8, lines 47-51; Col. 9, lines 27-41; Claim 5).

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Claims 16, 21-22 are allowable at least because they each depend upon an allowable base claim (base Claim 5 for Claim 16, base Claim 17 for Claims 21-22). For example, Claims 21-22 depend upon Claim 17, which recites the feature of "providing at least one of said plurality of certificates from said purchaser to a user". As discussed above, this feature is not taught or suggested in Messner. These dependent claims are further allowable for reciting patentable subject matter in their own right.

For at least these reasons, the Applicants respectfully request that the rejections under 35 U.S.C. 103 be withdrawn and Claims 5, 16, 21-22 be put in condition for allowance.

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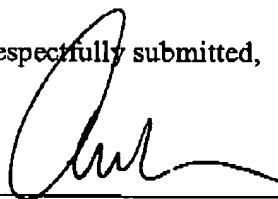
### Conclusion

It is believed that all of the pending claims have been addressed in this response. However, failure to address a specific rejection, issue, or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Claims 2, 4-28, 30-31 are in condition for allowance, and a notice to that effect is respectfully solicited.

No fee is believed to be due at this time. Please apply any other charges or credits to Deposit Account No. 06 1050.

Respectfully submitted,



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